

REMARKS

Claims 1-20 and 22-33 are pending in the above-referenced patent application. In this amendment, claims 1, 18, 20 and 22 have been amended, claims 21 and 34-35 have been cancelled and no claims have been added.

Status of Claims

It is noted that claims 1, 18, 20 and 22 were not amended to overcome rejections and objections, or in light of cited references. Rather, claims 1, 18, 20 and 22 were amended to more clearly delineate intended subject matter. Furthermore, it is believed that these amendments do not narrow claim scope and such claim scope may, in some circumstances, be broadened. Therefore, no prosecution history estoppel should result from these claim amendments.

Claim Rejections – 35 USC 102(b)

In the Final Office Action, dated March 30, 2006, the Examiner rejected claims 1, 2, 5, 10, 14, 16-24, 30, 32 and 34 under 35 U.S.C 102(b) as being anticipated by Tabuchi (US Patent No. 5,611,006); and rejected claims 1, 5, 7-10, 12-15, 18, 22, 24, 26, 27 and 32 under 35 U.S.C 102(b) as being anticipated by Spaeth (US Patent No. 6,021,238). The rejections are respectfully traversed.

Assignee respectfully submits that Tabuchi does not set forth each and every element of the rejected claims, as amended, and, therefore, contrary to the Examiner's assertion, the claims are not anticipated by Tabuchi under 35 U.S.C. 102(b). As just an example, referring to claim 1, as amended, Tabuchi does not show or describe at least a photonic package comprising at least "a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data.", as recited in claim 1, as amended.

The cited section of Tabuchi describes "The laser beam reflected at the cube type half mirror 18 is focused by the spherical lens 16a and becomes incident upon the edge incidence type photodiode chip 21. The laser beam incident upon the edge incidence type photodiode chip 21 is used for

stabilizing the output of the laser diode chip 20." [col 8:53-col 8:59]. Tabuchi does not provide any description of how "stabilizing" is performed, or what parameters may be used to stabilize an output of the laser diode chip. Additionally, Tabuchi does not show or describe "monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data." Tabuchi does not show or describe any "monitoring" of the light source of Tabuchi. According to the Examiner, "[A]ny signal that is received by a photodiode is *Inherently monitored* when it is detected." However, as stated in *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed.Cir.2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.Cir.1999)), "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." It is respectfully submitted that there has been no showing by the Examiner that monitoring of the light source is necessarily present in Tabuchi, and, therefore, Tabuchi does not show or describe monitoring a laser light source either expressly or inherently, and, therefore, does not anticipate claim 1, as amended.

Assignee respectfully disagrees with the Examiner's characterization of what constitutes monitoring. According to the definition providing by the Examiner, which assignee does not concede is the definition one skilled in the art would provide in the present context, monitoring means "to watch, keep track of, or check usually for a special purpose." It is respectfully submitted that in the present context, a laser beam may be received by a photodiode and used for purposes including stabilizing the output of a laser diode without necessarily monitoring the laser diode. For example, a laser beam may be detected by a photodiode, the photodiode may generate electrical signals in response to the detected laser beam, and the electrical signals may be utilized for stabilizing a laser diode, but the laser diode will not necessarily be watched, kept track of or checked for a special purpose, per the definition supplied by the Examiner. Therefore, because there has been no showing by the Examiner that monitoring of the light source is necessarily present in Tabuchi, the cited art does not anticipate claim 1, as amended.

Similarly, Spaeth does not show or describe at least one element of claim 1, as amended. As just an example, Spaeth does not show or describe at least a "a beam splitter cube (BSC) disposed

inside the housing to create a first split output comprising a reflected portion of said first light beam output; and a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data.", as recited in claim 1. The cited monitor diode (21) of Spaeth receives emitted radiation that passes through the beam-splitter layer (10). For example, quoting from col 7:36 – col 7:40 of Spaeth, "This monitor diode 21 serves essentially to check the wavelength of radiation 7 emitted by the transmit component 2. For this purpose, the beam-splitter layer 10 is constructed in such a way that it allows a portion of the emitted radiation 7 to pass through." As clearly shown by this cited passage of Spaeth, the monitor diode receives radiation that passes through the beam-splitter layer, and Spaeth does not show or describe "a photodetector disposed inside the housing to receive the first split output" where the first split output comprises "a reflected portion of said first light beam" as recited in claim 1, as amended.

It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. Assignee respectfully submits that because neither Tabuchi nor Spaeth disclose each and every element of the rejected claims, a prima facie case under 35 U.S.C. 102(b) has not been established, and claim 1, as amended, is in condition for allowance. Additionally, claims 2, 5, 7-10, 12-24, 26-27, 30 and 32 are in a condition for allowance for the same and/or similar reasons as presented with reference to claim 1, as amended. It is respectfully requested that the Examiner withdraw his rejections of these claims also. It is noted that claim 34 has been cancelled, and, therefore, this rejection to claim 34 is moot.

Claim Rejections – 35 USC 103(a)

The Examiner has rejected claims 3 and 4 under 35 U.S.C 103(a) as being unpatentable over Spaeth in view of Aksura et al. (US Patent No. 6,496,623); rejected claims 6 and 25 under 35 U.S.C 103(a) as being unpatentable over Tabuchi in view of Liedenbaum et al. (US Patent No. 5,701,396); rejected claims 11, 33 and 35 under 35 U.S.C 103(a) as being unpatentable over Tabuchi; rejected

claims 28 and 29 under 35 U.S.C 103(a) as being unpatentable over Spaeth in view of Kobayashi et al. (US Patent No. 4,627,688); and rejected claim 31 under 35 U.S.C 103(a) as being unpatentable over Tabuchi in view of Ishikura et al. (US Patent No. 5,920,420). These rejections are respectfully traversed.

It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, even if the cited references could be combined, although assignee does not concede that they could be successfully combined, any resultant combination would still not teach or suggest all the claim limitations.

For example, as mentioned previously, Spaeth does not show or describe at least "a beam splitter cube (BSC) disposed inside the housing to create a first split output comprising a reflected portion of said first light beam output; and a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data.", as recited in claim 1, as amended, from which claims 3 and 4 depend, and Aksura does not cure this deficiency. As just an example, Aksura does not show or describe "a photodetector disposed inside the housing to receive the first split output" as claimed in claims 3 and 4, and, therefore, even if these references could be combined, although, as stated previously, assignee does not concede that they could be successfully

combined, any resultant combination would still not teach or suggest all the claim limitations of claims 3 and 4.

Additionally, claims 6 and 25 are not rendered obvious by Tabuchi in view of Liedenbaum et al. Even if these references could be combined, although, as stated previously, does not concede that they could be successfully combined, any resultant combination would still not teach or suggest all the claim limitations, and, therefore, would still not render the claims obvious. As just an example, as mentioned previously, Tabuchi does not show or describe at least a photonic package comprising at least "a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data." and Liedenbaum et al. does not cure this deficiency. Liedenbaum et al. is related generally to multimode lasers, and does not show or describe at least a photodetector as claimed in claims 6 and 25.

Additionally, claims 11 and 33 are not rendered obvious by Tabuchi. As just an example, as mentioned previously, Tabuchi does not show or describe at least a photonic package comprising at least "a beam splitter cube (BSC) disposed inside the housing to create a first split output comprising a reflected portion of said first light beam output; and a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data." as claimed in claim 11, and claim 33 includes similar limitations. It is respectfully submitted that it would not have been obvious to one skilled in the art to modify the teachings of Tabuchi to include at least the limitations set forth above. Additionally, it is noted that claim 35 has been cancelled, therefore, this rejection is moot.

Additionally, claims 28 and 29 are not rendered obvious by Spaeth in view of Kobayashi et al. Even if these references could be combined, although Assignee has serious doubts concerning the

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ability to do so, any resultant combination would still not render the claims obvious. As just an example, as mentioned previously, Spaeth does not show or describe at least a "with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based at least in part on a comparison of the electrical signal to characterization data" and Kobayashi et al. does not cure this deficiency. Kobayashi et al. is related to multimode lasers, and does not show or describe at least a photodetector as claimed in claims 28 and 29.

Additionally, claim 31 is not rendered obvious by Tabuchi in view of Ishikura et al. As mentioned previously, Spaeth does not show or describe at least "an optical isolator structure optically coupled to the semiconductor light source and disposed inside the housing, the optical isolator structure having a beam splitter cube (BSC) to create a first split output comprising a reflected portion of said first light beam output; and a photodetector disposed inside the housing to receive the first split output, with the photodetector being adapted to produce an electrical signal responsive to the received first split output to facilitate monitoring of the semiconductor light source by: providing the electrical signal to a processor, the processor being adapted to calibrate the photodetector based, at least in part, on a comparison of the electrical signal to characterization data.", as recited in claim 22, as amended, from which claim 31 depends, and Ishikura et al. does not cure this deficiency. Ishikura et al. is related to a Faraday rotator, and does not show or describe at least a photodetector as claimed in claims 31, and, therefore, even if these references could be combined, although, as stated previously, assignee does not concede that they could be successfully combined, any resultant combination would still not teach or suggest all the claim limitations of claim 31.

Assignee respectfully submits that, for at least the reasons presented above, a prima facie case of obviousness has not been established, and, therefore, the rejected claims are in a condition for allowance. It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. It is respectfully requested that the Examiner withdraw this rejection of these claims.

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CONCLUSION

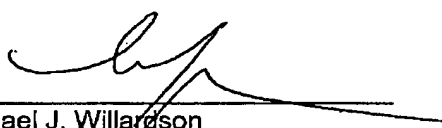
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

6/27/06


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